

REMARKS

Claims 1-32 were previously pending in the present application. No claims are currently canceled or added. Accordingly, claims 1-32 remain pending in the present application.

Reconsideration of the present application is respectfully requested in light of the following remarks.

Rejections under 35 U.S.C. §103: Wynn in view of Morgenthaler

Claim 1

Claims 1-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,667,751 to Wynn, et al. ("Wynn") in view of U.S. Patent Application Publication No. 2002/0032677 to Morgenthaler, et al. ("Morgenthaler"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1 and, therefore, with respect to claims 2-5 which depend from claim 1.

As provided in 35 U.S.C. §103:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as the Examiner concedes, Wynn fails to teach or suggest enabling searching of data associated with the screen shots. (Examiner's Office Action, page 3). Consequently, the Examiner cites Morgenthaler as allegedly disclosing enabling searching of data associated with the screen shots. However, Morgenthaler presents no such disclosure.

Initially, it should be noted that the present application introduces a Screen Shot File that contains a complete graphical image of each Web screen URL. However, also preserved in each

saved graphical image is any hyperlinks that each page contains. "Thus, the screen shot works just like it originally did where clicking on the hyperlink will take the user to it's coded address." (Present application, page 9, lines 5-8). Accordingly, in the context of claim 1, it is clear that the claimed data that is associated with the screen shots includes the hyperlinks that existed in the body of the captured Web page, and also that such hyperlinks are preserved in their active form in order to enable subsequent visits stemming from viewing the screen shot with preserved hyperlinks. Moreover, the hyperlinks preserved in such manner are included in the searchable data when the screen shots are searched.

In contrast, Morgenthaler specifically teaches storing only static screen shots of each URL, as well as any statistical data related to the URL, and fails to teach that the hyperlinks embedded within any Web page addressed by the stored URL are also preserved in active form, or that such hyperlinks are included in the searchable data that is accessed when the screen shots are searched. For example, Morgenthaler specifically provides:

[0128] ... The relational database is constructed by listing the URL's and their corresponding screen shots in a partitioned URL Table. As these URL's and screen shots are catalogued into this URL Table, associated information is also listed with each URL, such as an identification number, the linking URL, a title, a description, the URL's rank, the URL status as active or inactive, a timestamp designating cataloging time, attempts to retrieve the URL, the image size of the screen shot, the last time the file was updated, and a flag to notify editors of issues related to the URL. The second facet in constructing the relational database is creating a Category Table that contains individual category URL's to direct users to specific category topics, category identification numbers, and corresponding URL identifications numbers.

Thus, Morgenthaler does not teach that the active hyperlinks of a Web page are preserved with the graphical image of the page. Morgenthaler's exhaustive list of the data that is stored with each URL and corresponding screen shot (*i.e.*, the data in the relational database, the URL Table, and the Category Table) makes it clear that Morgenthaler fails to also preserve active

hyperlinks within each screen shot, in the context of claim 1 of the present application. If Morgenthaler had intended to preserve active hyperlinks within each screen shot, such hyperlinks would have been included in the list of URL and Category Table information types repeated above. However, the lists do not include active hyperlinks preserved within the screen shot. Thus, one skilled in the art would not interpret Morgenthaler to include any teaching that active hyperlinks are preserved with each screen shot, particularly in the context of claim 1 of the present application.

Moreover, Morgenthaler further provides that:

[0129] ... *The relational database's utility is promulgated by its advanced search and retrieval functionality. As queries are made to the relational database, searches of the URL Table and Category Table are executed, via a hierarchical relationship, for query matches. As matches from both categories are identified, a Matching Matrix is constructed for the query in which URLs and Categories with higher matching correlation are selected for the query retrieval of URLs in the searchable graphical database....*

This passage confirms that Morgenthaler's database is not searchable based on active hyperlinks preserved with each screen shot. That is, while Morgenthaler teaches the ability to search myriad types of information and statistics related to each URL in the relational database, the URL Table, and the Category Table, such queries cannot further access active hyperlinks preserved with each screen shot, in the context of claim 1 of the present application. In other words, because Morgenthaler fails to preserve active hyperlinks with each screen shot, it necessarily follows that Morgenthaler also fails to enable searching active hyperlinks preserved with the screen shots, in the context of claim 1.

Nonetheless, the Examiner points to the Abstract and paragraphs [0009] and [0049] of Morgenthaler as teaching the enablement of such searching. However, these cited portions of Morgenthaler specifically provide that the captured screen shot images are "static." That is, they do not preserve the active hyperlinks associated with the Web page being captured. The cited portions do mention cataloging or categorizing the captured images, but other portions of

Morgenthaler clearly explain that such categorization is with respect to title, description, rank, status, timestamp, etc. Nowhere, however, does Morgenthaler go further to explain that active hyperlinks of the captured Web pages can be preserved with the screen shots, or that such hyperlinks can be searched.

Thus, Wynn and Morgenthaler each independently fail to teach or suggest searching of active hyperlink data associated with the screen shots. Consequently, the combination of Wynn and Morgenthaler necessarily fails to teach or suggest each and every limitation of claim 1. Therefore, the Examiner has not met the burden of factually supporting a *prima case* of obviousness with respect to claim 1. Accordingly, Applicants respectfully request that the Examiner withdraw the §103 rejection with regard to claim 1 and its dependent claims.

Claim 17

Claims 17-21 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Wynn in view of Morgenthaler. As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, much in the same manner as described above with regard to claim 1, the combination of Wynn and Morgenthaler fails to teach or suggest a means to enable searching of data associated with the screen shots, as required by claim 17. Accordingly the §103 rejection of claim 17 and its dependent claims is not supported by the combination of Wynn and Morgenthaler. Therefore, Applicants respectfully request that the Examiner withdraw the §103 rejection of claim 17 and its dependent claims.

Rejections under 35 U.S.C. §103: Wynn in view of Morgenthaler and Chailleux

Claim 1

Claims 6-16, which depend from claim 1, were rejected under 35 U.S.C. §103(a) as being unpatentable over Wynn in view of Morgenthaler and in further view of U.S. Patent Application Publication No. 2005/0278629 to Chailleux ("Chailleux"). As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as also described above, the combination of Wynn and Morgenthaler fails to teach or suggest

enabling searching of data associated with the screen shots, as required by claim 1. Moreover, Chailleux fails to cure the shortcomings of the combination of Wynn and Morgenthaler, because Chailleux also fails to teach or suggest enabling searching of data associated with screen shots. Accordingly the §103 rejection of any claim depending from claim 1 is not supported by the combination of Wynn, Morgenthaler and Chailleux. Therefore, Applicants respectfully request that the Examiner withdraw the §103 rejection of claims 6-16.

Claim 17

Claims 22-32, which depend from claim 17, were also rejected under 35 U.S.C. §103(a) as being unpatentable over Wynn in view of Morgenthaler and in further view of Chailleux. As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, as also described above, the combination of Wynn and Morgenthaler fails to teach or suggest a means to enable searching of data associated with the screen shots, as required by claim 17. Moreover, Chailleux fails to cure the shortcomings of the combination of Wynn and Morgenthaler, because Chailleux also fails to teach or suggest a means to enable searching of data associated with screen shots. Accordingly the §103 rejection of any claim depending from claim 17 is not supported by the combination of Wynn, Morgenthaler and Chailleux. Therefore, Applicants respectfully request that the Examiner withdraw the §103 rejection of claims 22-32.

CONCLUSION

All matters set forth in the Office Action have been addressed. Accordingly, it is believed that all claims are in condition for allowance. Favorable consideration and an early indication of allowability are respectfully requested.

Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



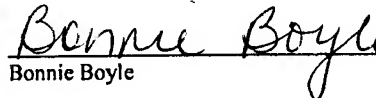
Dave R. Hofman
Registration No. 55,272

Dated: 10/19/07

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 713/547-2523
Facsimile: 214/200-0853
Attorney Docket No.: TS02-012/ 24061.455
Document No.: H-696874.1

Certificate of Service

I hereby certify that this correspondence is being filed with
the U.S. Patent and Trademark Office via EFS-Web on
Oct. 19, 2007.


Bonnie Boyle